

REMARKS

Claim 33 has been amended. New claim 55 has been added.

Rejection under 35 U.S.C. §102

Claim 33 was rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,430,604 to Ogle, et al. ("Ogle"). Applicant has amended claim 33 and submits that Ogle does not anticipate claim 33, as amended, for at least the reason that Ogle does not teach, "calling the subscriber at the predetermined telephone number and delivering the message and an identity of a sender of the message by voice synthesis," as is recited in claim 33. Therefore claim 33 should be in condition for allowance.

Rejection under 35 U.S.C. §103

Claim 34 was rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 6,430,604 to Ogle, et al. ("Ogle") in view of U.S. Patent No. 6,449,344 to Goldfinger, et al. ("Goldfinger"). Applicant traverses this rejection on the grounds that these references are defective in establishing a prima facie case of obviousness with respect to claim 34. As the PTO recognizes in MPEP § 2142, the Examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness. It is submitted that, in the present case, the examiner cannot factually support a prima facie case of obviousness for the following reasons.

The references do not combine to teach the claimed subject matter. The Examiner has admitted that Ogle, "fails to disclose responsive to the subscriber selecting a particular user from the subset of the predetermined user list, sending a message from the subscriber to the selected data network user using an instant message." The Examiner has relied on Goldfinger to satisfy the deficiencies of Ogle. However, the users and subscribers of Goldfinger are not telephone users, as is

required in claim 34. Thus the references as cited, do not teach all the elements of claim 34, and claim 34 should be allowable.

Secondly, the Examiner has not shown that either Ogle or Goldfinger provides any incentive or motivation to combine the two references to arrive at the combination resulting from claim 34. References may not be combined to produce a 35 U.S.C. §103 rejection absent basis in the art for doing so. The MPEP further provides at § 2143.01 that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. Since there has been no showing of a motivation to combine, claim 34 should be allowable.

Since no prima facie case of obviousness with respect to claim 34 has been shown, Applicant respectfully submits it is in condition for allowance. Claims 35-54 depend from and further limit independent claim 34 and should therefore be allowable as well.

Objections to the Claims

Claims 36-38, 40-42, and 54 were objected to as being dependent upon a rejected base claim. The Examiner indicated these claims would be allowable if written in independent format, including intervening claims. Applicant has incorporated the elements of claims 34, 53, and 54 into new claim 55, and submits that claim 55 is in condition for allowance.

Conclusion

It is respectfully submitted that all pending claims are in condition for allowance. Should the Examiner deem that any further amendment is desirable to place this application in condition for allowance, the Examiner is invited to telephone the undersigned at the below listed telephone number.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on August 23, 2004.

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